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08/941,174

09/30/1997

KEVIN J. BRUSKY

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07/20/2004

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FORT COLLINS, CO 80527-2400

EXAMINER

BROWN, RUEBEN M

ART UNIT

PAPER NUMBER

2611

39

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/941,174

Applicant(s)

BRUSKY ET AL.

Examiner

Reuben M. Brown

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5,8-12 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 8-12 & 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues on page 7 of the Appeal brief that the Gateway 2000 disclosure (Field Mouse Remote) teaches away from the claimed, 'alphanumeric keyboard containing a key associated with an associated channel macro for selecting a predetermined network name or Internet site name. Examiner respectfully disagrees. First of all, the feature that examiner pointed to as not being disclosed by the Gateway 2000 disclosure is the "key with an associated macro for selecting a predetermined network or Internet site name". This is because secondly, the Gateway 2000 disclosure does not limit user interaction with the PC/TV to the Field Mouse. Specifically, page 4 of the disclosure states that, "The *keyboard* sports an EZ PAD pointing device and a special 'baby-sitter' button that with one click, takes you to the television", emphasis added. Thus the wireless keyboard is a part of the PCTV system, and may be used to at least access the TV service, even though the disclosure only explicitly discusses the Field Mouse operating the TV. Nevertheless, examiner does not agree with applicant's assertion that the channel control features highlighted on page 2 refers to the Field Mouse.

Art Unit: 2611

The keypad 40 of Yoshida clearly has alphanumeric functions, see col. 3, lines 1-20. When the user in Yoshida selects the initial key of a broadcasting station, the list of station names that begin with this letter, is displayed on the screen, which reads on the claimed key with an associated macro for selecting a predetermined network or Internet site name.

The examiner concurs with the initial conclusion presented by applicant that the Gateway 2000 disclosure in view of Yoshida do not meet the claims 8, 20 & 24, nor establish a prima facie case. This is because these claims are rejected over three references, Gateway 2000 disclosure, in view of Yoshida & Siitonen.

With respect to Siitonen, applicant's main argument against the reference is that it is non-analogous art from Gateway 2000 disclosure and Yoshida. Examiner respectfully disagrees. Examiner points out that all three disclosures relate to personal display systems that enable users to retrieve audiovisual items, using computerized processes. Siitonen discloses that the PDA is essentially a portable electronic computer, col. 1, lines 16-17. Furthermore, Siitonen teaches that the list of items that may be searched includes Internet site names (col. 2, line 43), which reads on the claimed features.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

Art Unit: 2611

time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that examiner is relying upon the present invention as the blueprint. Again examiner respectfully disagrees. The Gateway 2000 disclosure clearly is a PCTV that encompasses the broad scope of the claims including a wireless keyboard an interactive channel selection. Yoshida teaches the motivation of overcoming the need for a user to remember the entire name of a TV station, by only needing to memorize the initial letter of the station By inputting the initial letter in Yoshida, the list of all stations that begin with that letter is displayed. Furthermore, Siitonen teaches when a particular list of items being searched contains many items, that a user can refine the search by adding additional letter(s), (col. 2, lines 51-67). The display then shows the list of items that contain the alphabets entered by the user; see col. 9, lines 45-64.

Therefore, it is clear that the motivations to combine Yoshida & Siitonen are provided by the references and the improvements are supported by the disclosures.

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5, 8-12 & 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gateway 2000 (Press Release, 08/21/1996), in view of Yoshida, (U.S. Pat # 5,191,423), in view of Siitonen, (U.S. Pat # 6,049,796).

Considering claim 8, Gateway 2000 meets the claimed PCTV computer system having a keyboard for providing alphanumeric characters to the PCTV computer and also a display monitor, pg. 3. Gateway 2000 discloses that the PCTV includes a keyboard and the TV display screen, pg. 4. The PCTV system also enables the user to place the system in one of a PC or TV mode; see pg. 2. The disclosure of the Destination Big Screen PCTV allows for watching TV in a full-size screen mode or as a resizable window in a PC desktop environment, which meets the newly claimed feature of TV mode and a computer mode with an active window.

The claimed feature of storing predetermined Internet site names is met by the disclosure, which teaches on pg. 1, that in the Destination Software Collection, at least Microsoft Works 95 may be pre-installed on the PCTV. The use of Microsoft Works 95 requires at least the Windows 95 operating system, which includes the Microsoft's Internet Explorer. Microsoft's Internet

Art Unit: 2611

Explorer is a web browsing software package and it at least includes the URL to the Microsoft web site, which reads on the claimed storing predetermined Internet site names.

Furthermore, the Destination Software Collection that comes with the PCTV of Gateway 2000, also includes Trials for on-line services and Internet access, which necessarily include web sites addresses, at least of the on-line services; see pg. 2. Thus the Gateway 2000 provides at least two ways of storing pre-determined Internet site names, and reads on the claimed subject matter.

As for the additionally claimed feature of storing predetermined station names, the recitation reads on at least temporarily storing an EPG at the PCTV. Gateway 2000 discloses on pg. 3 that a user may choose the option for an on-line TV service. By ordering the on-line TV guide service, the user may scroll through up to two weeks of programming. Even though it is not explicitly disclosed that this on-line TV guide data may be stored at the PCTV, Official Notice is taken that storing EPG data at a consumer network equipment, such as a set-top box was very well known in the art at the time invention was made. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Gateway 2000 in a manner wherein the EPG data is at least temporarily stored at the PCTV, at least in order to speed up the user's access to the EPG data since the data is stored locally instead of being retrieved from the network each time the user desires to view the data.

Regarding the additional claimed feature of the alphanumeric keyboard containing a key with an associated channel macro for selecting a predetermined network or Internet site name, Gateway 2000 does not explicitly disclose such a feature. Nevertheless, TV tuning systems were well known in the art at the time the invention was made which enabled a user to select a predetermined station by inputting its corresponding station name via alphanumeric keys on a user controlled station selection device.

Yoshida provides such a user controlled station selection device 40, Fig. 2. In particular, Yoshida teaches that the user selects a station by pressing the corresponding alphanumeric keys on the channel selection device 40, (col. 1, lines 55-67). Yoshida furthermore provides that the user merely needs to input the first letter of the desired station name, and subsequently the list of all stations with the corresponding first letter is displayed on the TV screen for the user to select from, (col. 1, lines 60-67; col. 4, lines 10-22). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Gateway 2000 with the known feature of a user inputting an alphanumeric representation of a station in order to select the instant station as shown by Yoshida, at least for the known desirable benefit of avoiding the user memorizing the entire name of a desired TV station, as taught by Yoshida.

Regarding the amended claimed feature of effecting a second actuation of the same or another alphanumeric key and creating a display of the or each stored station name or Internet site name containing an initial sequence of characters matching the sequence of characters associated with the sequence of alphanumeric key actuations, Yoshida only teaches entering the



Art Unit: 2611

first alphanumeric key actuation. Nevertheless, one of ordinary skill in the art would have been motivated to sort a list of stations using more than just the first alphabet, at least in order to provide the user with a narrower search.

It is taught by Siitonen, that when a user wants to search for a particular item in a database, for the user to enter the first few letters of the names. As the user enters the name of item, by entering multiple letters, the system automatically searches the database and provides a list of items that match the sequence of alphabets entered by the user; see col. 2, lines 51-64 & col. 9, lines 45-62. It would have been obvious for one of ordinary skill in the art, at the time the invention was made to modify the combination of Gateway 2000 and Yoshida, with well known feature of alphabetically sorting items using more than the first letter, as taught by Siitonen, col. 2, lines 51-54, for the improvement of providing the user with opportunity to refine a search.

Even though the teachings of Siitonen is applied in an environment of a searching for names or companies in a database, examiner points out that the searching algorithm is entirely applicable to the references of record. This is correct since all of the references are computer controlled, and both Yoshida & Siitonen are concerned with providing lists of items to a user-based upon the user's search request.

Considering claim 5, Gateway 2000 discloses a wireless keyboard, pg. 4.

Considering claim 9, the claimed step of downloading an EPG from a network provider reads on the discussion in Gateway 2000 of the electronic TV guide subscription.

Art Unit: 2611

Regarding claims 10 & 12, Official Notice is taken that highlighting and channel banners of a user selectable item were notoriously well known in the art of TV graphical user interface technology, at the time the invention was made. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Gateway 2000 in a manner wherein channel banners or highlighting of channels is used, at least for the well-known benefit of insuring that the user is informed of which channel has been selected.

Regarding claim 11, Gateway 2000 teaches a user watching TV, even while in computer mode; see pg. 2.

Considering claims 17-18 & 21-22, Gateway 2000 teaches using the wireless keyboard or Field Mouse remote control for operation of the TV; see pg. 4.

Considering claims 19 & 23, Gateway 2000 discloses that the PCTV has full screen TV mode, and a video window while in PC mode.

Considering claim 20, the claimed features of a computer system emulating a TV system, which corresponds with subject matter of claim 8, are likewise analyzed. As for the additionally claimed feature of channel macros operably associated predetermined TV networks, the feature reads on each letter being input in Yoshida, which generates a different list of broadcast stations.

Art Unit: 2611

The channel macros operably associated with an Internet network site, reads on the URL's listed in Siitonen when the user inputs the letters that represent the Internet site names.

Considering claim 24, the claimed method steps of the PCTV corresponds with subject matter mentioned above in the rejection of claims 8 & 20, and is likewise rejected. As for the additionally claimed feature of marking the identifier, Official notice is taken that at the time the invention was made; highlighting an item was a well-known GUI function. It would have been obvious for one of ordinary skill in the art at the time the invention was made to operate the combination of Gateway 2000, in view of Yoshida & Siitonen, with the technique of enabling a user to highlight an item on a list, at least for the desirable benefit of allowing the user to be sure that the correct item is selected before the selection is executed.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Keenan Teaches that remote control device for channel selection, may also be referred to as a keyboard, e.g., keyboard 200 (Fig. 2; col. 3, lines 20-25).

Art Unit: 2611

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*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington,  
VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.  
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the  
organization where this application or proceeding is assigned is (703) 872-9306 for regular  
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

  
VIVEK SRIVASTAVA  
PRIMARY EXAMINER